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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/277,213	03/26/1999	YASUSI KOBAYASHI	FUJO-12.880A	3219

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EXAMINER

HOM, SHICK C

ART UNIT

PAPER NUMBER

2666

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/277,213

Applicant(s)

KOBAYASHI ET AL.

Examiner

Shick C Hom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-95 is/are pending in the application.
- 4a) Of the above claim(s) 1-42, 45, 49, 51, 52 and 55-91 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43, 44, 46-48, 50, 53, 54, 94 and 95 is/are allowed.
- 6) ☒ Claim(s) 92 and 93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/518,110.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/02/02 have been fully considered but they are not persuasive.

In page 4 lines 14-20 and page 5 line 21 to page 6 line 2 of the amendment, applicant argued that Thor does not recite converting control data into a format that can be exchanged and communicating the control information through the switch is not persuasive because Thor in col. 4 lines 32-52 which recite the packet switching network having data receiving means for converting data received from a transmitting data terminal and data transmitting means for converting the data packet into data transmitted to a receiving data terminal whereby packet processing at the receiver includes separating the address field and control data from the data packet clearly anticipate converting control data into a format that can be exchanged and communicating control information through the switch as in claim 92.

In response to applicant's argument in page 5 lines 18-20 that the references fail to show certain features of applicant's

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invention, it is noted that the features upon which applicant relies (i.e., control information generated by the control processor is sent to the intra-station device) is not clearly recited in the rejected claim 92. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not indicate that foreign priority is claimed as indicated in page 4 lines 7-10 of the 3/29/02 amendment.

Specification

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

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Claim Rejections - 35 USC § 112

4. Claims 92-93 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 92 lines 10-11 which recite "said inter-station device" lacks clear antecedent basis because no inter-station device have been previously recited in the claim and therefore the limitation is not clearly understood; further it is not clear as to whether it is reciting ---said intra-station device--- of claim 92 line 6.

Claim 93 is rejected under 35 U.S.C. 112, second paragraph because it depends from rejected claim 92.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

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by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371⁹ of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 92 and 93 are rejected under 35 U.S.C. 102(e) as being anticipated by Thor.

Thor discloses all the subject matter now claimed. Note col. 5 lines 29-55 which recite the storing means supplying control information contained in the data frames to a control processor that updates contents of the storing means in a packet switching network clearly anticipate the switch station which exchanges a packet with a predetermined format, and the control

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processor controlling the switch station as in claim 92.

Further, Thor recites that the data receiving means converting data received from a transmitting data terminal into a data packet with an address field and data transmitting means for converting the data packet read into data transmitted to a receiving data terminal clearly anticipate the interface unit converting a data format of the control information into data format which the switch can exchange and the intra-station device performing a communication operating according to the control information as in claim 92. Col. 4 lines 32-52 which recite the packet switching network having data receiving means for converting data received from a transmitting data terminal and data transmitting means for converting the data packet into data transmitted to a receiving data terminal whereby packet processing at the receiver includes separating the address field and control data from the data packet clearly anticipate converting control data into a format that can be exchanged and communicating control information through the switch as in claim 92. Fig. 1 which shows the field diagram of the frame relay high-level data-link control format for the frame relay protocol defined in standards listed in Table 1 clearly

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anticipate the control information being communicated according to link access protocol as in claim 93.

Allowable Subject Matter

7. Claims 43-44, 46-48, 50, 53, 54, 94, and 95 are allowed.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. **Any response to this final action should be mailed to:**

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Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications; please
mark "EXPEDITED PROCEDURE")

Or:

(for informal or draft communications, please
label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal
Park II, 2121 Crystal Drive, Arlington. VA., Sixth
Floor (Receptionist).

Any inquiry concerning this communication or earlier
communications from the examiner should be directed to Shick Hom
whose telephone number is (703) 305-4742. The examiner's regular
work schedule is Monday to Friday from 8:00 am to 5:30 pm EST and
out of office on alternate Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao, can be reached at (703) 308-5463.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

SH

December 16, 2002

Seema S. Rao
SPE AU 2666
12/16/02